

AUG 03 2006

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END5005USNPIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Customer No : 000027777 Confirmation No. 9912
Applicants : Robert J. Dunki-Jacobs, et al.
Serial No. : 10/713,407 Art Unit: 3737
Filed : November 14, 2003 Examiner: Jung, William C.
For : METHODS AND DEVICES FOR DETECTING ABNORMAL
TISSUE CELLS

I certify this correspondence is being transmitted by facsimile to the United States Patent and Trademark Office on August 3, 2006.

/Andrew B. Ulmer/
Andrew B. Ulmer

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION TO WITHDRAW FINALITY OF OFFICE ACTION DATED March 9, 2006

Dear Sir:

Applicant hereby petitions the Director of Technology Center 3700 under 37 CFR 1.81 and MPEP 1002.02(c) to withdraw the finality of the Office Action dated March 9, 2006. The reasons why Applicant is entitled to the relief requested herein are as follows:

In the first Office Action, dated 06/30/05, the Office addressed claim limitations that were not recited in the present application as of the date of the Office Action. Notably, the Office did not address the claim limitations that were actually recited in the present application. The Office instead appeared to be addressing the claims of an entirely separate application (Serial No. 10/713,637). In the response filed by Applicant on 12/20/05, Applicant pointed out this defect to the Office, and respectfully requested that the Office make the next Office Action non-final in order to provide Applicant a full and fair opportunity to respond.

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The second Office Action, dated 03/09/06, was made final, and again addressed limitations that were not recited in the present application as of the date of the Office Action. Applicant maintains that such treatment of the claims was improper. In particular, in purporting to address claims 1 and 2 of the present application on page 3 of the Office Action 03/09/06, the Office stated as follows:

Kovacs et al disclose a system and method for detecting tissues comprising a capsule comprising a detector, a substance for associating with a target tissue where the substance is capable of being detected by the detector and a machine for verifying at least one of the detector and substance are suitable for use [sic] (col. 3, line 10 – col. 4, line 59; col. 6, lines 8-56).

Neither of claims 1 or 2 recited a capsule or a machine for verifying that a detector and substance are suitable for use, nor have they ever recited such features during the pendency of the present application. Incidentally, Applicant notes that the passage quoted above appears to deal with claim 11 that was pending in U.S. Application Serial No. 10/713,637 as of the date that the final Office Action was issued. In fact, the above-quoted passage appears to have been literally copied and pasted from the Office Action that was mailed on 01/26/2006 for U.S. Application Serial No. 10/713,637, which has substantively different claims. This appears to have been done despite Applicant pointing out in Applicant's prior response (filed 12/20/05) that, in the first Office Action issued against the present application, the Office was addressing claims not being prosecuted in the present application.

Because both Office Actions issued against the present application addressed claims of a separate application reciting substantively different subject matter, and because only the second/final Office Action remotely addressed, in the "Response to Arguments" section, the limitations actually recited in the claims of the present application, Applicant submits that the finality of the second Office Action was premature. The Office has not twice rejected the claims that have actually been pending in the present application. Applicant therefore respectfully requests that the finality of the Office Action dated 03/09/06 be withdrawn.

In an amendment after final filed by Applicant on 06/09/06, and pursuant to 37 CFR 1.181(c), Applicant respectfully requested the Examiner to reconsider the finality of the 03/09/06 Office Action in view of the foregoing circumstances. In an Advisory Action mailed 07/05/06, the Office did not grant Applicant's request. Applicant acknowledges that the present petition is being filed more than two months past the date of the 03/09/06 Office Action whose finality Applicant submits was premature. However, in view of MPEP 1002, Applicant submits

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that the present petition is nevertheless timely under 37 CFR 1.181(f) because it is being filed within two months of the Examiner's denial of Applicant's request for reconsideration of finality.

Finally, Applicant notes that a Request for Continued Examination (RCE) is being filed on even date herewith, along with authorization to charge Applicant's deposit account for the RCE fee of \$790, in order to have the Office enter the amendments that were filed after final on 06/09/06, and in view of 37 CFR 1.181(f). However, given that the 03/09/06 Office Action was not properly made final as outlined above, Applicant submits that the RCE should not be necessary. Accordingly, if the present petition is granted, Applicant further respectfully requests that the RCE fee of \$790, which is presently being paid by Applicant, be refunded to deposit account 10-0750/END5005USNP/GSG, and that the RCE be deemed moot.

Respectfully submitted,

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,407	11/14/2003	Robert J. Dunki-Jacobs	END-5005NP	9912
27777	7590	07/05/2006	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			JUNG, WILLIAM C	
			ART UNIT	PAPER NUMBER
			3768	

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

10/713,407

DUNKI-JACOBS ET AL.

Examiner
William JungArt Unit
3768

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AUG 03 2006

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 June 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 708.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because:
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see entry no. 11 below. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-15.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

ACJ

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Continuation Sheet (PTO-303)

Application No. 10/713,407

Continuation of 11. does NOT place the application in condition for allowance because: Claims 1-3 includes new limitation regarding target specific substance having affinity to particular cell types. This new limitation substantially changes the scope of the invention and thus require further search.


BRIAN L. CASLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700